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| 22879 7590 07/09/2008 HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400 | | | | |
| EXAMINER RIVIERE, HEIDI M | | | | |
| ART UNIT | | PAPER NUMBER | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/642,876

Applicant(s)

ZELANIS ET AL.

Examiner

HEIDI RIVIERE

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3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-30 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 22 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

RESPONSE TO ARGUMENTS

1. Applicant's arguments with respect to the rejection(s) of **claims 1-30** under **Junger et al. (US 2004/0172260 A1)** (hereinafter "**Junger**"); **Junger** in view of **Cales et al. (US 2003/0135421 A1)** (hereinafter "**Cales**"); **Junger** in view of **Cales** and further in view of **Nancy Paradis "Slow-moving Refund Suddenly Picked up Speed Series: Action; Recent recalls"**, St. Petersburg Times, Dec. 9, 2002, pg. 2.D (hereinafter "**Paradis**") and **Geof Wheelwright, "The Elusive Exchange Desk for Online Purchases: Who Hears Complaints?"** National Post, Jun. 21, 1999, pg. E.4. (hereinafter "**Wheelwright**") in view of **Cales** have been fully considered and are not persuasive. Applicant argues that **Junger** does not teach that the customer submits a product for return. However, since **Junger** does note in paragraphs 122 that various return criteria have to be met it should be understood that a product has to be submitted for this return to take place. Usually the customer/buyer will be doing the submitting. **Junger** is explicit in its teaching that a product return can be blocked for not meeting the return criteria. The **Junger** system also provides electronic notification of this occurrence. See Figure 10D. **Cales** aids in this understanding as it teaches a buyer protection service. The other details of the claims in the second and third rejections under section 103 providing details of credit card account, shipping and refund would be obvious from the teachings

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of Junger and the combination of the other references. Therefore, the rejections are not withdrawn.

2. The drawings were objected to because the figures were hand drawn. Examiner notes the replacement drawings in the system. Therefore the objection has been withdrawn.

3. The abstract was objected to because it exceeded the 150-word limit. The abstract has been amended and therefore the objection is withdrawn.

4. The Specification was objected to because the Technical Field section was confusing as written. Examiner notes the amendment of this section and therefore the objection is withdrawn.

5. **Claim 29** is objected to because of the following informalities: The term "lost" should be "loss". The appropriate correction has been made and therefore the objection is withdrawn.

6. **Claim 29** was also rejected under 112 paragraph 2 for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim has been amended, however based the amendments the rejection is not withdrawn. Please note the rejection below.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. **Claims 27 and 29** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim as written is missing steps that would further clarify the presented limitations.

9. Applicant amended claim 27 with the statement "preventing a computer in processing the return of the purchased product". First of all, Applicant should note that this claim is amended. Second of all, what is Applicant referring to in this amendment? Is "preventing a computer" part of the process? How is this accomplished? Who prevents the computer?

10. Claim 29 provides hypothetical limitations. This amendment to this claim lack clarity because one facet of the scenario is presented and not the other facet. Therefore, since the presented limitation may not happen Applicant is not claiming his invention. What happens if the vendor determines the purchased product was in fact received by the customer?

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international

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application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. **Claim 15** is rejected under 35 U.S.C. 102(e) as being anticipated by **Junger et al. (US 2004/0172260 A1)** (hereinafter “**Junger**”).

13. **With respect to claim 15: (currently amended)** Junger teaches:

- a product return blocking system configured to receive an order to purchase a product by a customer, determine if a return of the purchased product should be approved or not be approve; and block the return of the purchased product in order to prevent the return of the purchased product if the return of the purchased product is not approved; and (Fig. 10D; paragraph 123 – return not approved therefore the warehouse can retain rejected product and not return to the manufacturer).
- A computer configured to communicate with the blocking system; Said blocking system including programmed code to prevent the computer in processing the return of the purchased product if the return of the purchased product is blocked. (Fig. 10D; Paragraph 111-112, 116-124 – return side computer connects with manufactures computer; products screen for compliance with return criteria - product details are entered in the system; when system determines that product should not be returned "a note is displayed across the bottom of the screen of the Scan Hardware screen".)

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. **Claims 1-10, 12-14, 16-24 and 26-28** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Junger** in view of **Cales et al. (US 2003/0135421 A1)** (hereinafter “**Cales**”).

16. **With respect to claim 1: (currently amended)** Junger teaches:

- determining if a return of the purchased product should be approved or not be approved; (paragraph 122 “the manufacturer side computer 5230 then checks the electronic registration database to ensure that the identified product meets product return criteria) and
- if the return of the purchased product is not approved, then blocking the return of the purchased product in order to prevent the return of the purchased product. (paragraph 123 – return not approved therefore the warehouse can retain rejected product and not return to the manufacturer).
- Preventing a computer in processing the return of the purchased product if the return of the purchased product is blocked (Fig. 10D;

Paragraph 111-112, 116-124 – return side computer connects with manufactures computer; products screen for compliance with return criteria - product details are entered in the system; when system determines that product should not be returned "a note is displayed across the bottom of the screen of the Scan Hardware screen".)

Junger does not teach submitting, by the customer, an order to purchase a product from a vendor and shipping the purchased product to the customer. However, Cales teaches

- submitting, by the customer, an order to purchase a product from a vendor; (paragraphs 27 and 37 – buyer orders and pays for online purchase)
- shipping the purchased product to the customer; (paragraphs 27 and 37 – seller is directed to ship product to buyer when payment is cleared).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine determining whether to approve the return of a purchased product of Junger with the purchasing and shipping of the order to the customer because the customer first has to by the product to have grounds in a subsequent return.

17. **With respect to claims 2, 16 and 28:** Junger teaches if the return of the purchased product is approved, then accepting and processing the return of the purchased product. (paragraph 107 – approved return product is properly labeled for return to manufacturer).

18. **With respect to claims 3 and 17:** Junger teaches if the return of the purchased product has been blocked, then unblocking the return of the purchased product in some instances to permit the return of the purchased product. (Figs. 23 and 24 – product not approved can still have manager override of decision).

19. **With respect to claims 4 and 18:** Junger teaches the determination if return of the purchased product should be approved or not be approved includes a review of the order by a personnel of the vendor. (paragraph 103 – personnel at the local store reviews product for compliance with return requirements).

20. **With respect to claims 5 and 19:** Junger teaches the order is submitted by the customer to a call center. (paragraph 30 – consumer can determine whether product qualifies for return by using an automated 800 (toll-free) telephone number or the like).

21. **With respect to claims 6 and 20:** Junger teaches the limitations rejected above. However, while Junger does not disclose Cales teaches the order is submitted by a customer to an online shopping website. (paragraphs 27 and 37 – buyer orders and pays for online purchase).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to enable the customer to submit an order on an online shopping website because that enables the customer to order products from their home.

22. **With respect to claims 7 and 21:** Junger teaches blocking the return of the purchased product comprises: entering text information associated with the

purchased product to indicate that the return of the purchased product is to be denied. (paragraph 124 – when product does not qualify for return a note is placed at the bottom of the screen).

23. **With respect to claims 9 and 23:** Junger teaches blocking the return of the purchased product comprises: entering a text comment that indicates a reason why the return of the purchased product is blocked. (paragraph 124 – when product does not qualify for return a reason for being denied is written).

24. **With respect to claims 12 and 26:** Junger teaches blocking the return of the purchased product prevents an exchange of the purchased product with another product. (paragraphs 16 and 18 – when product does not qualify for return the ability to exchange product for another is lost and system not abused).

25. **With respect to claim 13: (currently amended)** Junger teaches:

- a machine-readable medium having stored thereon instructions to:
 - a. determine if a return of the purchased product should be approved or not be approved; (paragraph 103 – personnel at the local store reviews product for compliance with return requirements) and
 - b. block the return of the purchased product in order to prevent the return of the purchased product if the return of the purchased product is not approved; and (paragraph 123 – return not approved therefore the warehouse can retain rejected product and not return to the manufacturer)

- c. Preventing a computer in processing the return of the purchased product if the return of the purchased product is blocked (Fig. 10D; Paragraph 111-112, 116-124 – return side computer connects with manufactures computer; products screen for compliance with return criteria - product details are entered in the system; when system determines that product should not be returned "a note is displayed across the bottom of the screen of the Scan Hardware screen".)

Junger does not teach receive an order to purchase a product by a customer. However, Cales teaches receive an order to purchase a product by a customer. (paragraphs 27 and 37 – buyer orders and pays for online purchase)

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine determining whether to approve the return of a purchased product of Junger with the purchasing of the order by the customer because the customer first has to buy the product to have grounds in a subsequent return.

26. **With respect to claim 14: (currently amended)** Junger teaches:

- Means for determining if a return of the purchased product should be approved; paragraph 103 – personnel at the local store reviews product for compliance with return requirements)
- Means for blocking the return of the purchased product in order to prevent the return of the purchased product if the return of the purchase product is not approved; (paragraph 123 – return not

approved therefore the warehouse can retain rejected product and not return to the manufacturer)and

- Means for preventing a computer in processing the return of the purchased product if the return of the purchased product is blocked.
(Fig. 10D; Paragraph 111-112, 116-124 – return side computer connects with manufactures computer; products screen for compliance with return criteria - product details are entered in the system; when system determines that product should not be returned "a note is displayed across the bottom of the screen of the Scan Hardware screen".)

Junger does not teach, however Cales teaches:

- Means for receiving an order to purchase a product by a customer (paragraphs 27 and 37 – buyer orders and pays for online purchase)

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine determining whether to approve the return of a purchased product of Junger with the purchasing of the order by the customer because the customer first has to by the product to have grounds in a subsequent return.

27. **With respect to claims 8 and 22:** Junger teaches the text information is entered into a webpage provided by the product return blocking system.
(paragraphs 30 and 124 – when product does not qualify for return a note is

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placed at the bottom of the screen; return procedure can be initiated online via website).

28. **With respect to claim 27: (currently amended)** A method of blocking a return of products from a customer, the method comprising:

- checking a purchase history of the customer to determine if a return of the purchased product should be approved or not be approved; (paragraph 122 "the manufacturer side computer 5230 then checks the electronic registration database to ensure that the identified product meets product return criteria) and
- if the return of the purchased product is not approved, then blocking the return of the purchased product in order to prevent the return of the purchased product; and (paragraph 123 – return not approved therefore the warehouse can retain rejected product and not return to the manufacturer)
- preventing a computer in processing the return of the purchased product if the return of the purchased product is blocked (Fig. 10D; Paragraph 111-112, 116-124 – return side computer connects with manufactures computer; products screen for compliance with return criteria - product details are entered in the system; when system determines that product should not be returned "a note is displayed across the bottom of the screen of the Scan Hardware screen".)

Junger does not teach submitting, by the customer, an order to purchase a product from a vendor; shipping the purchased product to the customer. However, Cales teaches:

- submitting, by the customer, an order to purchase a product from a vendor; (paragraphs 27 and 37 – buyer orders and pays for online purchase)
- shipping the purchased product to the customer; (paragraphs 27 and 37 – seller is directed to ship product to buyer when payment is cleared)

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine checking purchase history of customer and determining whether to approve the return of a purchased product of Junger with the purchasing and shipping of the order to the customer because the customer first has to by the product to have grounds in a subsequent return.

29. **Claims 11 and 25** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Junger** in view of **Cales** and further in view of **Nancy Paradis "Slow-moving Refund Suddenly Picked up Speed Series: Action; Recent recalls"**, St. Petersburg Times, Dec. 9, 2002, pg. 2.D (hereinafter "**Paradis**").

30. **With respect to claims 11 and 25:** Junger/Cales teach the limitations rejected above. However, while Junger/Cales do not teach, Paradis teaches blocking the return of the purchased product prevents a refund to the customer

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for the purchased product. (page 1, Full Text, paragraphs 4 and 5 – no refund or exchanges without proof of purchase for damaged goods).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to prevent giving a customer a refund when the return of the product has been blocked because the refund was not authorized and can't be validated.

31. **Claims 29 and 30** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Geof Wheelwright, "The Elusive Exchange Desk for Online Purchases: Who Hears Complaints?"** National Post, Jun. 21, 1999, pg. E.4. (hereinafter "**Wheelwright**") in view of **Cales**.

32. **With respect to claim 29: (currently amended)** Wheelwright teaches:

- shipping a replacement product to the customer if the vendor determines that the purchased product has not been received by the customer; (page 2, 3rd full paragraph – Wal-Mart Online ships replacement product to customer)
- charging a cost of the replacement product to an account of the vendor; (page 2, 3rd full paragraph – Wal-Mart Online ships replacement product to customer and will not charge customer)
- if the customer returns one of the purchased product or the replacement product, then accepting a return of the purchased product or the replacement product and preventing a credit of a customer account of the customer; and crediting the account of the

vendor for the returned product. (page 2, 3rd full paragraph – Wal-Mart Online ships replacement product to customer and will not charge customer for pickup of returned good)

- notifying the vendor by the customer, that the purchased product has not been received by the customer (page 1, full text paragraph 3 – “What if you don’t get what you ordered? When you are unhappy about your purchase in a real, bricks- and –mortar retail store, you can go back to the store, complain, and eventually have things right.”)

However, while Wheelwright does not teach, Cales teaches:

- submitting, by the customer, an order to purchase a product from a vendor; (paragraphs 27 and 37 – buyer orders and pays for online purchase)
- shipping the purchased product to the customer; (paragraphs 27 and 37 – seller is directed to ship product to buyer when payment is cleared)
- investigating, by the vendor, a possible loss of the purchased product; (paragraph 40 – seeking reason from vendor for explanation of why product was not delivered)

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine sending a replacement product and charging the cost to the vendor account of Wheelwright with the purchasing and shipping

of the order to the customer because the of the motivation to make customer satisfied when they are in need of a replacement product.

33. **With respect to claim 30:** Wheelwright teaches the account of the vendor comprises a company credit card of the vendor. (page 2, 3rd full paragraph – Wal-Mart Online ships replacement product to customer and will not charge customer).

Furthermore, the data identifying the type of account a vendor can have is non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; *see also Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional

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and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that the data identifying the type of account a vendor can have adds little, if anything, to the claimed acts or steps and thus do no serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is non-functional descriptive data. The subjective interpretation of the data does not patentably distinguish the claimed invention.

CONCLUSION

34. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heidi Riviere whose telephone number is 571-270-1831. The examiner can normally be reached on Monday-Friday 9:00am-5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**Name: /H. R./
Examiner, Art Unit 3689**

Title: Examiner

**/Janice A. Mooneyham/
Supervisory Patent Examiner, Art Unit 3689**

Date: